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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s): Robert R. Turvey )  
Serial No.: 09/872,378 )  
Filed: June 1, 2001 )  
For: METHOD AND APPARATUS )  
FOR PRODUCING PLASTIC BAGS )  
Group Art Unit: 3721 )  
Examiner: John Roger Paradiso )  
Docket No.: J-2904 )  
Customer No.: 29471 )

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January 20, 2006

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APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
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Sir:

This reply brief is filed in response to the Examiner's Answer dated November 21, 2005.

**I. INTRODUCTION**

The Examiner's Answer fails to address many of the appellant's arguments. To the extent the Answer does address certain arguments, it is wholly conclusory and relies on no evidence in support of the claims of obviousness. These omissions and unsubstantiated assertions highlight the deficiencies in the appealed rejections and support appellant's position that the examiner should be reversed.

## II. ARGUMENT

First, the Answer does not dispute appellant's definition of the word "indicia," which is "a distinctive mark that indicates or that is felt to indicate the nature or quality or existence or reality of something." Webster's Third New International Dictionary, 1150 (3d ed. 2002). In fact, the examiner notes that the word "indicia" is "broadly defined as 'distinctive marks' (Merriam Webster Dictionary) and [that] the patterned marks on the endstops of THIEMAN are distinctively patterned."

Second, the examiner fails to identify how the marks on the endstops of THIEMAN "indicate the nature or quality or existence or reality of something." The examiner merely argues in the Answer that "while [the cross-hatching] may not appear distinctive in the manner Appellant states, the cross-hatching shown by THIEMAN are nevertheless distinctive in that they are not haphazardly placed, nor in a variety of patterns." However, whether a marking is haphazardly disposed on a material or is placed on the material in an orderly manner is irrelevant to whether the marking acts as an indication of "the nature or quality or existence or reality of something." The examiner has not and cannot point to any disclosure in Thieman that provides or suggests the use of the incidental markings on the endstops of Thieman as an indication of anything other than that the markings themselves exist. Further, the example provided by the examiner that the markings on the endstop of Thieman "would, for instance, enable a machine operator to tell by looking if the weld were performed properly or not" is wholly unsubstantiated.

Third, the examiner fails to address appellant's arguments asserting a new and unobvious functional relationship between printed matter in the form of indicia designating at least one of a production line that produced a plastic bag and a time at which the bag was produced in combination with the remaining claimed elements of the plastic bag. As noted in the Appeal Brief, a functional relationship is evidenced by interdependence between the printed matter and the other claimed elements. See *In Re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004) (unpublished). The interdependence between the printed matter and the plastic bag is evidenced by the fact that the indicia designating the production line and/or the time of production cannot indicate the specific plastic bag without being disposed thereon and a specific plastic bag cannot indicate the production line and/or time of production without some form of indicia thereon. The examiner's silence with respect to appellant's argument

further buttresses appellant's contention that a functional relationship exists between the combination of the plastic bag and the indicia thereon.

Finally, appellant contended in the Appeal Brief that while it is necessary to establish a new and unobvious functional relationship between a claimed combination comprising printed matter and other elements, the functional relationship requirement is not relevant to the question of patentability of method claims. However, it has recently come to appellant's attention that the Federal Circuit required a functional relationship to be found between printed matter and other elements of method claims in the unpublished opinion of *In Re Bruce Levin*, 1997 U.S. App. LEXIS 1781, at \*5 (Fed. Cir. 1997) (unpublished). In the interest of reducing the burden on the Board of Patent Appeals and Interferences and to further the advancement of good faith arguments, appellant concedes this issue of law and acknowledges that a functional relationship must exist between the printed matter and the other elements in the method claims at issue in the present application.

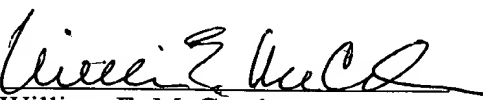
### III. CONCLUSION

In summary, the claims at issue are not obvious over the Thieman reference. Specifically, the rejection should be reversed because a new and unobvious functional relationship exists between the indicia and the plastic bag.

Reconsideration and allowance of the claims at issue are respectfully requested.

Respectfully submitted,

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